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<div data-bbox="105 52 316 283"><p>APR 26 2004</p><p>RECEIVED</p></div>	<b>TRANSMITTAL OF APPEAL BRIEF (Small Entity)</b>	Docket No. 1429.002
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Re Application Of: **Brockley et al.**

Serial No. 09/783,366	Filing Date February 14, 2001	Examiner Davis, C.	Group Art Unit 3611
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Invention: **SPORTS COMMEMORATOR FOR DISPLAYING A SPORTS RELATED OBJECT AND PICTURE**

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

Applicant is a small entity under 37 CFR 1.9 and 1.27.

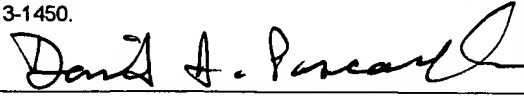
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- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 08-1935.

  
Signature

Dated: April 22, 2004

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<b>David A. Pascarella</b> Typed or Printed Name of Person Mailing Correspondence

cc:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Brockley et al.

Serial No.: 09/783,366

Group Art Unit: 3611

Filed: February 14, 2001

Examiner: Davis, C.

Title: SPORTS COMMEMORATOR FOR DISPLAYING A SPORTS  
 RELATED OBJECT AND PICTURE

CERTIFICATE OF MAILING

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David A. Pascarella  
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Date of Signature: April 22, 2004.

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BRIEF OF APPELLANTS

Dear Sir:

This is an appeal from a final rejection, dated October 24, 2003, rejecting claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45, all the claims being considered in the above-identified application. This Brief is accompanied by a check comprising payment of the requisite fee set forth in 37 C.F.R. §1.17(c).

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### REAL PARTY IN INTEREST

This application is assigned to Sportsaver by virtue of an assignment executed by the co-inventors on June 15, 2001, and recorded with the United States Patent and Trademark Office at reel 011905, frame 0979, on June 18, 2001. Therefore, the real party in interest is Sportsaver.

### RELATED APPEALS AND INTERFERENCES

To the knowledge of the appellants, appellants' undersigned legal representative, and the assignee, there are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

### STATUS OF CLAIMS

This patent application was filed on February 14, 2001 with the United States Patent and Trademark Office. As filed, the application included 35 claims in which three (3) were independent claims (i.e., claims 1, 17, and 32).

In a first substantive Office Action dated September 18, 2001, claims 1-11 and 17-24 were rejected under 35 U.S.C. 102(b) as allegedly being unpatentable over Feher (U.S. Patent No. 861,822), claims 11-16 and 25-35 were rejected under U.S.C. §103(a) as allegedly being unpatentable over Feher in view of Rand (U.S. Patent No. 405,678), and claims 14-16, 29-31, and 33-35 were rejected under U.S.C. §103(a) as allegedly being unpatentable over Feher and Rand and further in view of Hickey, Jr. (U.S. Patent No. 5,845,778). In appellants' response dated December 18, 2001, no claims were amended, and claims 2-4, 14-16, 18-20, 29-31, and 33-35 were canceled.

In a second and final Office Action dated March 7, 2002, claims 1, 5-11, 17, and 21-24 were rejected under 35 U.S.C. 102(b) as allegedly being unpatentable

over Feher (U.S. Patent No. 861,822), and claims 11-13, 25-28, 32, and 36 were rejected under U.S.C. §103(a) as allegedly being unpatentable over Feher in view of Rand (U.S. Patent No. 405,678).

A telephone interview was conducted with Examiner Davis on April 21, 2002. Although no agreement was reached, amending the claims to recite the following features was believed to better distinguish appellants' invention over the applied prior art:

- 1) positively reciting the sports related picture and object;
- 2) reciting the picture relates to the object;
- 3) reciting the first transparent portion buttressing the picture and the second transparent portion conforming to or being just sized to fit the shape of the object; and
- 4) reciting the picture being behind the object and the cover.

A Request For Continued Examination and Amendment And Response Under 37 C.F.R. §1.114 was filed on June 7, 2002, in which claims 10-12, 25-27, and 36 were canceled, and claims 1, 13, 17, 28, and 32 were amended as discussed during the telephone interview.

In a third Office Action dated August 30, 2002, claims 1, 5-9, 13, 17, 21-24, 28, and 32 were rejected under U.S.C. §103(a) as allegedly being unpatentable over Hickey, Jr. (U.S. Patent No. 5,845,778) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678).

In appellants' response dated January 30, 2003, claims 1, 17, and 32 were amended, and new claims 37-45 were added.

In a fourth Office Action dated May 9, 2003, claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 were rejected under U.S.C. §103(a) as allegedly being unpatentable

over Wilson et al. (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678).

In appellants' response dated August 7, 2003, no claims were amended.

In a fifth and final Office Action dated October 24, 2003, claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al. (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678).

A Notice of Appeal to the Board of Patent Appeals and Interferences was filed on February 24, 2004. The status of the claims is therefore as follows:

Claims allowed – none;

Claims objected to – none;

Claims rejected – 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45; and

Claims canceled – 2-4, 10-12, 14-16, 18-20, 25-27, 29-31, and 33-36.

Appellants are appealing the rejection of claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45.

#### STATUS OF AMENDMENTS

No claim amendment was effectuated by the Response to Final Office Action dated October 24, 2003. The claims as set forth in the Appendix include all prior entered claim amendments.

#### SUMMARY OF INVENTION

Briefly summarized, appellants' invention is directed to sports commemorators for displaying a related sports object and picture. For example, as shown in one embodiment in FIGS. 1 and 2, a sports commemorator includes a

cover 104 having a first transparent portion and a second transparent portion. The cover extends over the picture with the second transparent portion forms a chamber 106 that is configured for receiving the sports related object.

Appellants' sports commemorator, for example as shown in FIG. 2, also visually associates the sports related object and the picture, such as in suggesting flight, location, or address of the golf ball relative to a golf fairway, golf lie, golf green, golf tee box. As shown in FIG. 5, a miniature racing car may be visually associated with a picture of a racetrack, and as shown in FIG. 6, a fishing lure may be visually associated with a picture of the fisherman.

### ISSUES

1. Whether claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Wilson et al, (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678).

### GROUPING OF CLAIMS

There is one ground of rejection, and thus, one group of claims, Group I. Group I includes claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45; however, the claims of Group I do not stand or fall together. Instead, each of the following subgroups of Group I includes claims that provide a separate basis of patentability:

- (i) claims 1, 5-9, 13, 17, 21-24, 28, and 32;
- (ii) claims 37, 40, and 43;
- (iii) claims 38, 41, and 44; and
- (iv) claims 39, 42, and 45.

## ARGUMENT

### Group I, Subgroup (i): Claims 1, 5-9, 13, 17, 21-24, 28, and 37-42

As noted above, claims 1, 5-9, 13, 17, 21-24, 28, and 37-42 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al, (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678). Appellants respectfully submit that the rejection of this subgroup is erroneous for the reasons below, and, therefore, respectfully request reversal of this rejection.

Appellants' invention is directed to sports commemorators for displaying a related sports object visually associated with a picture.

Moreover, appellants' sports commemorators as recited in independent claims 1, 17, and 32 includes in combination 1) a cover having a first transparent portion that extends over the picture and a second transparent portion configured for receiving the sports related object, 2) a sports related object or representation thereof which is used by a participant in engaging in the sport, 3) a picture illustrating a scene relating to the sports related object, 4) the sports related object being visually associated with the picture, and 5) the sports related object not obscuring the picture.

Since the applied art does not teach or suggest the above-outlined concepts, appellants respectfully request reversal of the stated obviousness rejection.

With reference to Wilson et al., Wilson et al. disclose a cap display apparatus having transparent member conforming to a baseball-style hat and secondary display section below the hat for displaying one or more tickets to an event associated with the hat. Alternative embodiments disclosed by Wilson et al. include a second hollow portion adapted for displaying a golf ball, a baseball, or other small memento associated with the hat being displayed.

However, Wilson et al. do not disclose, teach or suggest the backing material having a picture thereon. Moreover, Wilson et al. do not disclose, teach or suggest 1) a display surface having a scene relating to the sports related object, 2) the sports related object being visually associated with the picture, or 3) the sports related object not obscuring the picture.

A careful reading of Wilson et al. fails to uncover any teaching, suggestion or implication of the problem addressed by appellants' invention for a sports commemorator. Instead, Wilson et al. address the problem of mounting a baseball-style hat on a wall.

With reference to Rand, Rand discloses a cabinet for preserving and displaying game such as a bird. The cabinet includes a cover made of glass with a projection or bulge that extends over and is spaced-apart from the stuffed game. The cover also extends over and is spaced-apart from a picture illustrating a scene of a beach and ocean.

Appellants respectfully disagree with the position taken in the final Office Action (paragraph 5) that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct a display surface of the backing material of the cap display apparatus taught by Wilson et al. with a picture on the backing material that corresponds with the three-dimensional object as taught by Rand to enhance the appearance of the display, as a basis for rejecting the claims.

While Rand discloses a picture on the backing material that corresponds with a three-dimensional object, Rand does not disclose, teach or suggest 1) a picture illustrating a scene that corresponds with a sports related object or a representation usable by a participant in engaging the sport, 2) a picture illustrating a scene relating to such a sports related object, 3) such a sports related object being visually associated with the picture illustrating the scene, or 4) such a sports related object not obscuring the picture illustrating the scene.



In this respect, appellants also respectfully disagree with the position taken in the final Office Action (paragraph 15) in connection with Rand that the bird is an object used by the participant in the sport of hunting by providing an object or target in which the hunter aims.

In Rand, the cabinet for preserving and displaying game includes a bird that is not an object usable by the hunter, but instead, an animal under pursuit. In the context of hunting, a gun or a rifle for example, would be an object usable by a hunter in aiming at the bird under pursuit in hunting, and not the bird.

In addition, the proposed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. In this case, the attempted proposed combination of Wilson et al. and Rand changes the principle of operation of the display disclosed in Wilson for showing off the cap, and in particular showing off the logos, insignia, emblems, symbols, designs, etc. which are typically embroidered on the front of the cap. More particularly, Wilson et al. specifically disclose that a "piece of backing material 33 provides a contrasting background for the cap 21." See, Wilson at column 2, lines 60-61. *Merriam Webster's Collegiate Dictionary*, Tenth Edition, 1993, defines "contrast" as "juxtaposition of dissimilar elements (as color, tone, or emotion) in a work of art." Attempting to incorporate a picture (if possible) into the cap display apparatus of Wilson et al. would result in the logos, insignia, emblems, symbols, designs, etc. embroidered on the front of the cap being less visible to an observer. Thus, attempting to incorporate a picture into the cap display apparatus of Wilson et al. improperly changes the basic principal under which the display in Wilson is constructed for showing off the cap with a contrasting background.

Furthermore, it is not clear how a picture would be incorporated in the cap display apparatus device of Wilson et al. since the cap itself occupies almost the entire display, let alone the sports related object being visually associated with and not substantially obscuring the picture.

With reference to Feher, Feher discloses an embossed picture showing a scene of a historical or biblical nature. The embossed picture includes a frame for supporting an embossed piece of celluloid that can be suitably colored, painted or printed to produce a life-like effect of a person in the picture. The embossed picture also includes an outer celluloid sheet. Feher fails to disclose, teach or suggest, the features lacking in Wilson et al. and Rand, as noted above, for supporting a rejection of claims 1, 17, and 32.

Based on the foregoing, appellants respectfully request reversal of the obviousness rejection of claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45.

Group I, Subgroup (ii): Claims 32 and 43-45

Claims 37, 40, and 43 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al, (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678). Appellants respectfully request reversal of this rejection.

In addition to the reasons set forth above in connection Group I, Subgroup (i), the combination of Wilson et al., Rand, and Feher, also fail to disclose teach or suggest the feature of "said scene comprises an image of a person associated with [such a] sports related object" as recited in dependent claims 37, 40, and 43.

Based on the foregoing, appellants respectfully request reversal of the obviousness rejection of claims 37, 40, and 43.

Group I, Subgroup (iii): Claims 38, 41, and 44

Claims 38, 41, and 44 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al, (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678). Appellants respectfully request reversal of this rejection.

In addition to the reasons set forth above in connection Group I, Subgroup (i), the combination of Wilson et al., Rand, and Feher, also fail to disclose teach or suggest the feature of "said scene comprises a scene illustrating an actual location associated with [such a] sports related object " as recited in dependent claims 38, 41, and 44.

Based on the foregoing, appellants respectfully request reversal of the obviousness rejection of claims 38, 41, and 44.

Group I, Subgroup (iv): Claims 39, 42, and 45

Claims 39, 42, and 45 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al, (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678). Appellants respectfully request reversal of this rejection.

In addition to the reasons set forth above in connection Group I, Subgroup (i), the combination of Wilson et al., Rand, and Feher, also fail to disclose teach or suggest the feature of "said scene comprises a scene illustrating an actual location commemorating an occasion where [such a] sports related object is used " as recited in dependent claims 39, 42, and 45.

Based on the foregoing, appellants respectfully request reversal of the obviousness rejection of claims 39, 42, and 45.

CONCLUSION

For all of the reasons noted above, appellants respectfully request reversal of the rejections of the pending claims as set forth in the final Office Action

Respectfully submitted,

A handwritten signature in black ink, reading "David A. Pascarella". The signature is fluid and cursive, with the first name "David" and last name "Pascarella" clearly legible. The signature is positioned above a horizontal line.

David A. Pascarella  
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Dated: April 22, 2004.

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APPENDIX

1. A sports commemorator comprising:
  - an object comprising at least one of an actual sports related object usable by a participant in engaging in a sport and a representation of a sports related object usable by a participant in engaging in a sport;
  - a picture on a layer, said picture illustrating a scene relating to said sports related object;
  - a cover;
  - a support formed with forward and rearward portions;
  - said forward portion having an open interior for displaying said picture on said layer and said object superimposed with said cover;
  - said cover formed with first and second transparent portions, said first transparent portion serving to buttress said layer in said open interior, said second transparent portion conforming to the shape of said object in said open interior;
  - a forward interface between said forward portion and a peripheral portion of said cover; and
  - a rearward interface between said layer and said rearward portion, wherein said forward and rearward interfaces serve to secure said cover and said layer for displaying said picture behind said object and said cover in said open interior so that said sports related object is visually associated with and does not substantially obscure said scene.
2. (Canceled)
3. (Canceled)
4. (Canceled)
5. The commemorator of claim 1 wherein said cover comprises a transparent member.

6. The commemorator of claim 1 wherein said first transparent portion is formed substantially flat, and wherein said second transparent portion is formed with a chamber having sufficient space to substantially cup said object.
7. The commemorator of claim 1 wherein said support includes at least one of a frame and a backing.
8. The commemorator of claim 1 wherein at least one of said forward and rearward interfaces comprises at least one of a stop and a fastener.
9. The commemorator of claim 1 wherein at least one of said forward and rearward interfaces is formed integrally with said support.
10. (Canceled)
11. (Canceled)
12. (Canceled)
13. The commemorator of claim 1 wherein said picture comprises a photograph.
14. (Canceled)
15. (Canceled)
16. (Canceled)

17. A sports commemorator comprising:

an object comprising at least one of an actual sports related object usable by a participant in engaging in a sport and a representation of a sports related object usable by a participant in engaging in a sport;

a picture on a layer, said picture illustrating a scene relating to said sports related object;

a transparent member;

a support formed with forward and rearward portions;

said forward portion having an open interior for displaying said picture on said layer and said object superimposed with said transparent member;

said transparent member formed with an expanse including a hollow protuberance, a section of said expanse serving to buttress said layer in said open interior, said hollow protuberance conforming to the shape of said object in said open interior;

a forward interface between said forward portion and a peripheral portion of said transparent member; and

a rearward interface between said layer and said rearward portion, wherein said forward and rearward interfaces serve to secure said transparent member and said layer for displaying said picture behind said object and said cover in said open interior so that said sports related object is visually associated with and does not substantially obscure said scene.

18. (Canceled)

19. (Canceled)

20. (Canceled)

21. The commemorator of claim 17 wherein said section of said expanse is formed substantially flat, and wherein said hollow protuberance has sufficient space to substantially cup said object.

22. The commemorator of claim 17 wherein said support includes at least one of a frame and a backing.
23. The commemorator of claim 17 wherein at least one of said forward and rearward interfaces comprises at least one of a stop and a fastener.
24. The commemorator of claim 17 wherein at least one of said forward and rearward interfaces is formed integrally with said support.
25. (Canceled)
26. (Canceled)
27. (Canceled)
28. The commemorator of claim 17 wherein said picture comprises a photograph.
29. (Canceled)
30. (Canceled)
31. (Canceled)



32. A method for displaying a sports related object and picture, the method comprising:

- selecting an object comprising at least one of an actual sports related object usable by a participant in engaging in a sport and a representation of a sports related object usable by a participant in engaging in a sport;

- selecting a picture on a layer, the picture illustrating a scene relating to the sports related object;

- selecting a support having an open interior;

- selecting a cover having a transparent expanse with a transparent chamber conforming to the shape of the object in the open interior;

- superimposing the transparent chamber over the object in the open interior;

- superimposing the transparent expanse over and buttressing the picture on a layer in the open interior; and

- securing the object and the layer in the open interior, whereby the object and the picture are displayed with the picture behind the object and the cover in the open interior so that the sports related object is visually associated with and does not substantially obscure the scene.

33. (Canceled)

34. (Canceled)

35. (Canceled)

36. (Canceled)

37. The commemorator of claim 1 wherein said scene comprises an image of a person associated with said sports related object.

38. The commemorator of claim 1 wherein said scene comprises a scene illustrating an actual location associated with said sports related object.
39. The commemorator of claim 1 wherein said scene comprises a scene illustrating an actual location commemorating an occasion where said sports related object is used.
40. The commemorator of claim 17 wherein said scene comprises an image of a person associated with said sports related object.
41. The commemorator of claim 17 wherein said scene comprises a scene illustrating an actual location associated with said sports related object.
42. The commemorator of claim 17 wherein said scene comprises a scene illustrating an actual location commemorating an occasion where said sports related object is used.
43. The method of claim 32 wherein the scene comprises an image of a person associated with the sports related object.
44. The method of claim 32 wherein the scene comprises a scene illustrating an actual location associated with the sports related object.
45. The method of claim 32 wherein the scene comprises a scene illustrating an actual location commemorating an occasion where the sports related object is used.

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